

REMARKS

As a preliminary matter, the Notice of Non-Responsive Reply is respectfully traversed because the Preliminary Amendment filed October 3, 2002, was not a response filed under 37 C.F.R. §§ 1.111 or 1.116 but merely an amendment filed in conjunction with a Continued Prosecution Amendment under 37 C.F.R. § 1.53(d). Nevertheless, in an effort to expedite prosecution without a Petition to the Director, Applicant hereby resubmits a Preliminary Amendment within the time period for response to the Notice of Non-Responsive Reply.

By this amendment, claims 1-14 and 16-35 are pending, in which claim 15 is canceled without prejudice or disclaimer, claims 1, 3, 6-10, 13-14, and 16-19 are amended, and claims 30-35 are newly presented without the introduction of new matter (see, e.g., FIG. 2, and Specification pp. 11-15).

The Office Action mailed June 27, 2002, requested a copy of the IDS filed September 2, 1998, rejected claims 6 under 35 U.S.C. § 112, second paragraph, for indefiniteness, claims 1, 6, 13, 16 and 17 under 35 U.S.C. § 102(e) as anticipated by *Hebert* (US 5,826,030), claims 2-4, 7-9, 12, 14, 18-20, 23-27, and 29 under 35 U.S.C. § 103(a) as obvious over *Dickerman et al.* (US 6,188,761) in view of *Hebert*, claims 10, 15, and 21 over *Dickerman et al.* and *Hebert* in view of the Background section of the disclosure, claims 5, 11, and 22 over *Dickerman et al.* and *Gottlieb* (US 5,920,621) in view of *Hebert*, and claim 28 over *Dickerman et al.* and *Sherman et al.* (US 6,108,337) in view of *Hebert*. The present application, *Dickerman et al.*, *Gottlieb*, and *Sherman et al.* are all commonly assigned to MCI.

In response to the request for a copy of the IDS filed September 2, 1999, the same has already been submitted or will be submitted hereafter.

In response to the rejection of claim 6 under 35 U.S.C. § 112, claim 6 has been amended. In addition, the specification and claims 1, 3, 6-10, 13, 14, and 16-19 have been amended to

correct discovered informalities and new claims 30-40 have been added. No new matter is introduced and all of the present claims are in compliance with 35 U.S.C. § 112.

The rejection of claims 2-5, 7-12, 14, 15, and 18-29 is respectfully traversed, because *Dickerman et al.*, *Gottlieb*, and *Sherman et al.* cannot preclude patentability for obviousness in light of the recent enactment of the American Inventors Protection Act (AIPA), Pub. L. 106-113, § 4807, effective for all applications filed on or after November 29, 1999. As amended, 35 U.S.C. § 103(c) provides:

(c) Subject matter developed by another person, which qualifies as prior art only under subsection (e), (f), or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention as made, owned by the same person or subject to an obligation of assignment to the same person.

The present application is a CPA filed after the November 29, 1999 enactment date of this provision of the AIPA and is therefore entitled to benefit from the AIPA's prior art exclusion for certain commonly assigned patents. The present application has a filing date of June 12, 1998, which is before the February 13, 2001 issue date of *Dickerman et al.*, the July 6, 1999 issue date of *Gottlieb*, and the August 22, 2000 issue date of *Sherman et al.* Thus, *Dickerman et al.*, *Gottlieb*, and *Sherman et al.* would qualify as prior art only under subsections (e), (f), or (g) of § 102. Since both the present application and *Dickerman et al.*, *Gottlieb*, and *Sherman et al.* are commonly assigned (to MCI), the use of *Dickerman et al.*, *Gottlieb*, and *Sherman et al.* in the obviousness rejection is disallowed by law.

Turning now to the rejection of claims 1, 6, 13, 16 and 17, claim 1 has been amended to recite a feature from claim 3, claim 15 has been canceled, and claims 3, 6, 13, 16, and 17 have been amended to correct discovered informalities and so as to depend from amended claim 1. Claims 2-14 and 16-19 depend from amended claim 1, which recites "a switch controller coupled to said

programmable switch, and including **a service control means for interfacing with an intelligent service network component of said intelligent service network,**” and which as acknowledged in the present Office Action is not disclosed by *Hebert* and together with any material that has been properly incorporated by reference (hereinafter, “Excel Inc.”).

Specifically, the present Office Action, at page 7, correctly acknowledges that “Excel Inc. does not appear to explicitly teach the claimed ‘... switch controller ... service control means for interfacing with said intelligent services network component’” The present Office Action relies on *Dickerman et al.*, for the claimed “service control means,” which as noted above cannot be used in an obviousness rejection. Accordingly, claims 1-14 and 16-19 are allowable over *Hebert* and *Dickerman et al.* (and/or *Gottlieb* and/or *Sherman et al.*).

Dependent claim 6, 13, 16, and 17, are allowable over *Hebert* on their own merits and for at least the reasons as argued above with respect to amended independent claim 1.

Turning now to new claims 30-35, new independent claim 30 is directed to a communication system for providing telecommunication services and independent claim 35 is directed to method for processing a call in a telecommunications system. Notably, new independent claim 30 recites:

a switch controller configured to generate the program instructions to the switch **for distributing the call to a plurality of network components** based on availability of the network components, wherein the network components and the switch controller are connected over a common data network; and

independent claim 35 recites:

transmitting program instructions to the switch for answering a call received by the switch from a telephony network and for **selectively distributing the call to one of the ports corresponding to the network components** based on availability of the network components, wherein the network components have connectivity to a common data network.


Hebert is directed to a universal host 130 to switch 110 applications program interface (API), but otherwise fails to satisfy these features. New independent claims 30 and 35, and their dependent claims, should thus be indicated as allowable.

Therefore, the present application, as amended, overcomes the objections and rejections of record and is in condition for allowance. Favorable consideration is respectfully requested. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at (703) 425-8508 so that such issues may be resolved as expeditiously as possible.

Respectfully Submitted,

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Date



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